

Appl. No. 10/074,758
Amendment and/or Response
Reply to Office action of November 13, 2003

Page 4 of 6

REMARKS/DISCUSSION OF ISSUES

Claims 1-7 are pending.

Rejections of Claims 1-7 under 35 U.S.C. §103(a)

The Office Action rejects claims 1-7 under 35 U.S.C. §103(a) over Justel et al. (US 6,559,598) and Murata et al. (US 6,611,099). Applicants respectfully traverse that rejection.

US 6,559,598 is prior art to the subject application only under 35 U.S.C. §102(e). The subject application was filed after November 29, 1999 (on 2/12/02), and thus 35 U.S.C. §103(c) provides that subject matter developed by another which qualifies as prior art only under 35 U.S.C. §102(e) shall not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

STATEMENT PER M.P.E.P §706.02(I)(2)

After investigation and on information and belief, the undersigned attorney asserts that at the time the subject invention was made, both the subject invention and US 6,559,598 were commonly owned or subject to an obligation of assignment to Koninklijke Philips Electronics, N.V.

Support.

As shown on pages 2 and 3 of attachment 1, US 6,559,598 (Serial Number 09/795,616) was assigned by its four inventors (three of which are inventors of the subject application) on 29 March 2001 to U. S. Philips Corporation. As shown on page 1 of attachment 1, on 27 February 2003 U.S. Philips Corporation assigned all of its interest to Koninklijke Philips Electronics, N.V. As shown on the top of page 1 of attachment 2, in response to an inquiry by the undersigned attorney (see the

Atty. Docket No. DE-010040

Appl. No. 10/074,758
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Pag 5 of 6

bottom of page 1 of attachment 2) U.S. Philips Corporation is owned 100% by Koninklijke Philips Electronics, N.V. Further, as shown on the top of page 1 of Attachment 4, that position is supported by an email from Philips Electronics Attorney Eric Bram. Example 1 of M.P.E.P. §706.02(I)(2) provides that for purposes of 35 U.S.C. §103(c) that patents owned by wholly owned subsidiaries of a Parent company are owned by the Parent company. Consequently, at the time of the invention, US 6,559,598 was for purposes of 35 U.S.C. §103(c) owned by Koninklijke Philips Electronics, N.V.

The subject invention was assigned shortly after filing to Koninklijke Philips Electronics, N.V., reference attachment 3. Consequently, at the time the invention was made the subject invention and US 6,559,598 were, for the purposes of 35 U.S.C. §103(c), both owned by Koninklijke Philips Electronics, N.V., and thus US 6,559,598 is not prior art to the subject invention.

The remaining reference, Murata et al. (US 6,611,099), does not teach or suggest any of the pending claims. For example, Murata et al. does not teach the combination of the UV layer 8 and the protective layer 5 of the subject application.

According, withdrawal of the 35 U.S.C. §103(a) rejection of claims 1-7 is respectfully requested

CONCLUSION

The applicants submit that all pending claims are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly requested.

If the Examiner deems that a telephone call would further the prosecution of this application, the Examiner is invited to call Mr. Eric Bram at (914) 333-9635. All correspondence should continue to be sent to the address of record (not to the signing attorney).

Atty. Docket No. DE-010040


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Pag 6 of 6

If these papers are not considered timely filed by the United States Patent and Trademark Office, or if any additional fees are required, kindly charge that fee to deposit account number 20-0782.

Respectfully submitted,

Jan 12, 2004


John M. Kelly, Attorney
Reg. No. 33,920
(732) 530-9404

Moser, Patterson & Sheridan, LLP
Attorneys at Law
595 Shrewsbury Avenue
Suite 100
Shrewsbury, NJ 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808

Atty. Docket No. DE-010040

ATTACHMENT 1

Page 1

ASSIGNMENT

Docket No. DE000031

U.S. PHILIPS CORPORATION, a Delaware Corporation having an office at 1251 Avenue of the Americas New York, NY 10020, in consideration of one dollar and other good and valuable consideration, the receipt of which is hereby acknowledged, hereby sells, assigns, and transfers the entire right, title, and interest in the following patent application to **KONINKLIJKE PHILIPS ELECTRONICS, N.V.**, having a place of business at Groenewoudseweg 1, 5621 BA Eindhoven, The Netherlands, its successors, assigns, and legal representatives, including any nominees (collectively the "Assignee"):

Application No.: 09/795,616 Filing Date: 02/28/2001

including all divisions, continuations, reissues, and extensions, and all patents granted on these applications.

The Assignor will provide its cooperation to enable the Assignee to enjoy the foregoing right, title, and interest to the fullest extent. Upon request of and at the expense of the Assignee, Assignor agrees to execute all papers, take all rightful oaths, testify in all legal proceedings including patent prosecutorial actions and infringement actions, and do all other such acts which may be necessary, desirable, or convenient for securing and maintaining patents on the foregoing invention or for perfecting title thereto in the Assignee. Assignor authorizes and requests that these patents be issued to the Assignee.

Assignor certifies that it has the full right to convey the above rights.

Dated: 27 February 2003

U.S. PHILIPS CORPORATION

By 
Matthieu van Kaam
Vice President

Page 2
Docket No. PIDE000031

ASSIGNMENT

U.S.A. Sole/Joint

For good and valuable consideration, of which I acknowledge receipt, I, as a below-named assignor, sell and assign to U.S. Philips Corporation (hereinafter "Assignee") a corporation existing under the laws of the State of Delaware, whose business address is 1251 Avenue of the Americas, New York, NY 10020-1104, its successors and assigns, the application for a United States Patent for the improvements in a "Plasma picture screen with UV light emitting layer" invented by us, which application:

- ☐ is executed concurrently herewith
☐ was executed by me/us on
☒ is Serial No. 09/795616 filed 28.02.2001
☐ is International Application No. filed

and all rights in and to said application, and all Patents which may be granted therefor, and all divisions, reissues, continuations and extensions thereof, and authorize and request the Commissioner of Patents and Trademarks to issue all Patents on said improvements or resulting therefrom to said Assignee as assignee of the entire interest and covenant that I have full right so to do, and agree that I will communicate to said Assignee or its representatives any facts known to me respecting said improvements and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid said Assignee, its successors, assigns and nominees, to obtain and enforce proper protection for said invention.

29 March 2001
Date

(sign name here)
(print name here)

Thomas JUSTEL

Assignor

29 March 2001
Date

(sign name here)
(print name here)

Hans-Helmut BECHTEL

Assignor

29 March 2001
Date

(sign name here)
(print name here)

Harald GLÄSER

Assignor

Page 3

2/2

PHDB000031 US

29 March 2001

Date

(sign name here)

(print name here)

Walter MAYR

Assignor

(sign name here)

(print name here)

Hans NIKOL

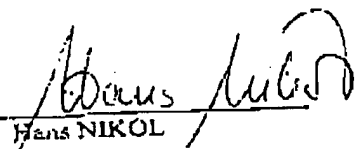
Assignor

Date

Page 4

2/2

PHDF000031 US

_____	(sign name here)	_____	Assignor
Date	(print name here)	Walter MAYR	
29 March 2001	(sign name here)		Assignor
Date	(print name here)	Hans NIKOL	

Page 1

ATTACHMENT 2



edna.chapa@philips.com
m
01/07/2004 01:46 PM

To: JKelly@mpsllp.com
cc:
Subject: Re: Fw: IMPORTANT: DE 010040

Hi John,

Eric is not in today. In regards to the answer to your email yes U.S. Philips Corp. is owned 100% by Koninklijke Philips Electronics N.V. so the inventions are commonly owned.

Kind regards,

Edna Chapa
Legal Assistant

Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Courier/visiting address:
Philips Intellectual Property & Standards
345 Scarborough Road
Briarcliff Manor, New York 10510
Tel: (914) 945-6000
Tel: (914) 333-9610
Fax: (914) 332-0615
e-mail : edna.chapa@philips.com
Intranet: pww.ips.philips.com
Internet:www.ip.philips.com

To: Edna Chapa/BRQ/IPS/PHILIPS@AMEC
Eric Bram/BRQ/IPS/PHILIPS@AMEC
cc: Eamon_J_Wall@domino.mpsllp.com
Lina_Genovesi@domino.mpsllp.com
Subject: Fw: IMPORTANT: DE 010040

JKelly@mpsllp.com

Classification:

2004-01-07 12:12 PM

Eric and Edna:

I received the fax from Edna regarding inventorship of the subject application. Thanks.
However, we still have a problem. The reference we are trying to remove (US 6,559,598) was originally assigned to U.S. Philips Corporation on 29 March 2001, but was not assigned to Koninklijke Philips Electronics, N.V. until 27 February 2003. The subject application was filed on Feb. 12, 2002 and was

Page 2

originally assigned to Koninklijke Philips Electronics, N.V. So, the question is, on Feb. 12, 2002 were both US 6,559,598 and the subject application commonly assigned?

The answer depends on the relationship between U.S. Philips Corporation and Koninklijke Philips Electronics, N.V. If U.S. Philips Corporation is owned 100% by Koninklijke Philips Electronics then according to MPEP 706.02(l)(2) the inventions are commonly owned, US 6,559,598 can be removed as a reference, and DE 010040 should issue as is. Otherwise, I need to make technical arguments that I would rather not make to avoid any possible estoppel.

Be advised that we have missed the 6 week response date (I needed the foregoing information) but we can still make the 2 month response date of January 13.

John M. Kelly
Moser, Patterson & Sheridan LLP
595 Shrewsbury Ave.
Shrewsbury, NJ 07702

Phone: 732-530-9404 x1127
Fax: 732-530-9808
Cell: 202-744-4787

--- Forwarded by John M Kelly/MPS on 01/07/2004 12:01 PM ---

eric.bram@philips.com

To: JKelly@mpsllp.com

12/23/2003 04:11 PM

cc:

Subject: Re: IMPORTANT: DE 010040

John,

Please get this sort of information from Edna. I suggest working with her (or whoever is taking over for her here on a particular day) by telephone.

Eric M. Bram
Senior Intellectual Property Counsel

Philips Intellectual Property & Standards
Philips Electronics N.A. Corp.
P.O. Box 3001
Briarcliff Manor, NY 10510-8001 USA
Visiting address:
345 Scarborough Road
Phone: 914-333-9635; Facsimile: 914-332-0615; Cell: 845-216-9339
E-mail: eric.bram@philips.com
Intranet: pww.ips.philips.com
Internet: www.ip.philips.com
Switchboard: 914-945-6000

To: eric.bram@philips.com

edna.chapa@philips.com

cc: Eamon_J_Wall@domino.mpsllp.com

Lina_Genovesi@domino.mpsllp.com

Subject: IMPORTANT: DE 010040

JKelly@mpsllp.com

Page 3

Classification:

2003-12-22 01:21 PM

Eric:

The subject application is on FINAL based on a 103(a) combination that includes reference Justel et al. (US 6,559,598). Technical distinctions between the subject application and Justel exist and were argued in the first response (which necessitated a new ground of rejection). Those distinctions could support an Appeal.

However, we can probably remove Justel as a reference and get this case without further costs. Justel is believed to be prior art only under 102(e), thus 103(c) should allow us to remove Justel as prior art. I believe that Justel and the subject invention were commonly assigned (or subject to an assignment) at the time of the invention (both are understood as being assigned to Koninklijke Philips Electronics N.V.). Can you help me verify this?

I would like a copy of the assignment of Justel et al. (US 6,559,598) to Koninklijke Philips Electronics N.V. If possible, I would also like copies of the employment agreements of the inventors of the subject application DE 010040 (Hans-Helmut Bechtel; Thomas Juestel, Harald Glaeser, Joachim Opitz) or some other proof that the inventors were under an obligation to assign their invention.

Thanks,

John M. Kelly
Moser, Patterson & Sheridan LLP
595 Shrewsbury Ave.
Shrewsbury, NJ 07702

Phone: 732-530-9404 x1127
Fax: 732-530-9808
Cell: 202-744-4787

ATTACHMENT 3

Page 1

DE 010040

Form PTO 1595
(Rev. 8-93)RECORDATION FORM COVER SHEET
PATENTS ONLYU.S. Dept. of Commerce
Patent and Trademark Office

To the Commissioner for Patents: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

HANS-HELMUT BRCHTEL
THOMAS JUESTEL
HARALD GLAESER
JOACHIM OPITZAdditional name(s) of conveying party(ies)
attached? Yes ☐ No ☒

2. Name and address of receiving party(ies):

Name: KONINKLIJKE PHILIPS ELECTRONICS N.V.

Street Address: GROENEWOUDSEWEG 1

City: 5621 BA EINDHOVEN

Country: THE NETHERLANDS

Additional name(s) & address(es) attached?

Yes ☐No ☒

3. Nature of conveyance:

☐

Assignment

☐

Merger

☐

Security Agreement

☐Change of
Terms☒Other: Please change the third
inventor's name from "Glaeser,
Harald" to --Glaeser, Harald--.Execution Date: 3/11/2002; 3/13/2002; 3/13/2002;
3/15/2002

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the
application, is

A. Patent Application No.(s)

10/074,758

B. Patent No.(s)

Additional numbers attached? ☐Yes ☒

No

5. Name and address of party to whom correspondence
concerning document should be mailed:Name: PHILIPS ELECTRONICS NORTH AMERICA
CORPORATION

Street Address: 580 WHITE PLAINS ROAD

City: TARRYTOWN State: NY Zip: 10591

6. Total number of applications and patents
involved:

1

7. Total fee (37 CFR 3.41) ...\$40.00

☐

Enclosed

☒Authorized to Deposit
Account

8. Deposit Account Number: 14-1270

(Attach duplicate copy of this page paying
by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached
copy is a true copy of the original document.Eric Bram, Reg. No. 37,285
Name of Person Signing

Signature

DATE

Total number of pages including cover sheet, attachments, and document: 4

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents and Trademarks
Box Assignments
Washington, D.C. 20231

PC

S:\BR\DE010040Deposit Letter Form PTO1595 for KPENV.BR.doc

UNITED STATES
PATENT AND
TRADEMARK OFFICE

Page 2

BRAM

JULY 08, 2002

PTAS

Under Secretary of Commerce For Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
www.uspto.govPHILIPS ELECTRONICS NORTH AMERICA
CORPORATION
ERIC M. BRAM
580 WHITE PLAINS ROAD
TARRYTOWN, NY 10591

102080067A

DE 010040

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 04/22/2002

REEL/FRAME: 012854/0443
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
BECHTEL, HANS-HELMUT

DOC DATE: 03/11/2002

ASSIGNOR:
JUESTEL, THOMAS

DOC DATE: 03/13/2002

ASSIGNOR:
GLASSER, HARALD

DOC DATE: 03/13/2002

ASSIGNOR:
OPITZ, JOACHIM

DOC DATE: 03/15/2002

ASSIGNEE:
KONINKLIJKE PHILIPS ELECTRONICS
N.V.
GROENEWOUDSEWEG 1
5621 BA EINDHOVEN, NETHERLANDSSERIAL NUMBER: 10074758
PATENT NUMBER:FILING DATE: 02/12/2002
ISSUE DATE:

PC 101 1.5 2002

Page 3

012854/0443 PAGE 2

SHARON LATIMER, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

-07-2002

Page 4

DE010040

Form PTO 1595
(Rev. 6-93)

RECORDATION FORM COVER SHEET

102080067

OFFICE OF PUBLIC RECORDS

To the Commissioner for Patents: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):
HANS-HELMUT BRCHTEL
THOMAS JUESTEL
HARALD GLAESER
JOACHIM OPITZ

FINANCE SECTION

Additional name(s) of conveying party(ies) attached?

☐

Yes

☒

No

3. Nature of conveyance:

☒

Assignment

☐

Merger

☐

Security Agreement

☐

Change of Terms

☐

Other

Execution Date: 3/11/02, 3/13/02, 3/13/02, 3/15/02

2. Name and address of receiving party(ies):

Name: Koninklijke Philips Electronics N.V.

Internal Address:

Street Address: Groenewoudseweg 1
5621 BA Eindhoven, The Netherlands

Additional name(s) & address(es) attached?

☐

Yes

☒

No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application, is

A. Patent Application No.(s)

10/074,758

B. Patent No.(s)

Additional numbers: ☐ed?☒

No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Philips Electronics North America Corporation

Internal Address:

Street Address: 580 White Plains RoadCity: Tarrytown State: NY Zip: 10591

6. Total number of applications and patents involved:

1

7. Total fee (37 CFR 3.41) ...\$40.00

☐

Enclosed

☒

Authorized to Deposit Account

8. Deposit Account Number: 14-1270

(Attach duplicate copy of this page paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Eric M. Bram, Reg. 37,285
Name of Person Signing

Signature

4/14/02
DateTotal number of pages including cover sheet, attachments, and document: 3

Mail documents to be recorded with required cover sheet information to:

Commissioner for Patents
Box Assignments
Washington, D.C. 20231

15/06/2002 LMUELLER: 00000187-141270-10074758

11. FE:581

40.00 CH

U.S.A. Sale/Joint

ASSIGNMENT

Docket No. PHDE010040

Page 5

For good and valuable consideration, of which I acknowledge receipt, I, as a below-named assignor, sell and assign to Koninklijke Philips Electronics N.V. (hereinafter "Assignee") a corporation existing under the laws of the Kingdom of the Netherlands, whose business address is Groenewoudseweg 1, 5621 BA Eindhoven, the Netherlands, its successors and assigns, the application for a United States Patent for the improvements in a

"Plasma picture screen with enhanced luminance" invented by us, which application:

- ☐ is executed concurrently herewith
☐ was executed by me/us on
☒ is Serial No. 10/074,758..... filed 12 February 2002.....
☐ is International Application No. filed.....

and all rights in and to said application, and all Patents which may be granted therefor, and all divisions, reissues, continuations and extensions thereof, and authorize and request the Commissioner of Patents and Trademarks to issue all Patents on said improvements or resulting therefrom to said Assignee as assignee of the entire interest and covenant that I have full right so to do, and agree that I will communicate to said Assignee or its representatives any facts known to me respecting said improvements and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid said Assignee, its successors, assigns and nominees, to obtain and enforce proper protection for said invention.

11 March 2002 (sign name here) Hans-Helmut Bechtel ,Assignor
 Date (print name here) Hans-Helmut BECHTEL

13 March 2002 (sign name here) Thomas Juestel ,Assignor
 Date (print name here) Thomas JUESTEL

13 March 2002 (sign name here) Harald Glaeser ,Assignor
 Date (print name here) Harald GLAESER

15 March 2002 (sign name here) Joachim Opitz ,Assignor
 Date (print name here) Joachim OPITZ

ATTACHMENT 4



eric.bram@philips.com

01/08/2004 02:33 PM

To: JKelly@mpsllp.com

cc: Eamon_J_Wall@domino.mpsllp.com, edna.chapa@philips.com,
Lina_Genovesi@domino.mpsllp.com, jack.slobod@philips.com

Subject: Re: Fw: IMPORTANT: DE 010040

John,

U.S. Philips Corp. is a wholly-owned indirect subsidiary of Koninklijke Philips. We assert that the reference is appropriately disqualified as prior art under 35 USC § 103(c) at least because, while we did not get around to changing the assignment of the referenced patent to Koninklijke until later, at the time of the invention in question they were certainly both "subject to an obligation of assignment to the same person," i.e., to Koninklijke Philips. Which subsidiary would have the literal assignment was a matter of convenience, but at all times Koninklijke Philips had the full power to dictate the assignment. Therefore the invention was always subject to an obligation of assignment to the same person.

Eric M. Bram
Senior Intellectual Property Counsel

Philips Intellectual Property & Standards
Philips Electronics N.A. Corp.
P.O. Box 3001
Briarcliff Manor, NY 10510-8001 USA
Visiting address:
345 Scarborough Road
Phone: 914-333-9635; Facsimile: 914-332-0615; Cell: 845-216-9339
E-mail: eric.bram@philips.com
Intranet: pww.ips.philips.com
Internet: www.ip.philips.com
Switchboard: 914-945-6000

To: Edna Chapa/BRQ/IPS/PHILIPS@AMEC
Eric Bram/BRQ/IPS/PHILIPS@AMEC
cc: Eamon_J_Wall@domino.mpsllp.com
Lina_Genovesi@domino.mpsllp.com
Subject: Fw: IMPORTANT: DE 010040

JKelly@mpsllp.com

Classification:

2004-01-07 12:12 PM

Eric and Edna:

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Cell: 202-744-4787

— Forwarded by John M Kelly/MPS on 01/07/2004 12:01 PM —

eric.bram@philips.com

To: JKelly@mpsllp.com

12/23/2003 04:11 PM

cc:

Subject: Re: IMPORTANT: DE 010040

John,

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Eric M. Bram
Senior Intellectual Property Counsel

Philips Intellectual Property & Standards
Philips Electronics N.A. Corp.
P.O. Box 3001
Briarcliff Manor, NY 10510-8001 USA
Visiting address:
345 Scarborough Road
Phone: 914-333-9635; Facsimile: 914-332-0615; Cell: 845-216-9339
E-mail: eric.bram@philips.com
Intranet: pww.ips.philips.com
Internet: www.ip.philips.com
Switchboard: 914-945-6000

To: eric.bram@philips.com

edna.chapa@philips.com

cc: Eamon_J_Wall@domino.mpsllp.com

Lina_Genovesi@domino.mpsllp.com

Subject: IMPORTANT: DE 010040

JKelly@mpsllp.com

2003-12-22 01:21 PM

Classification:

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John M. Kelly
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Shrewsbury, NJ 07702

Phone: 732-530-9404 x1127
Fax: 732-530-9808
Cell: 202-744-4787

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